

REMARKS

A. BACKGROUND

The present Amendment is in response to the Office Action mailed September 17, 2008. Claims 1-20 were pending and rejected in view of cited art.¹ Claims 1, 10, and 15 are amended. Claims 1-20 remain pending in view of the above amendments.²

Reconsideration of the application is respectfully requested in view of the above amendments to the claims and the following remarks. For the Examiner's convenience and reference, Applicant's remarks are presented in the order in which the corresponding issues were raised in the Office Action.

Please note that the following remarks are not intended to be an exhaustive enumeration of the distinctions between any cited references and the claimed invention. Rather, the distinctions identified and discussed below are presented solely by way of example to illustrate some of the differences between the claimed invention and the cited references. In addition, Applicant requests that the Examiner carefully review any references discussed below to ensure that Applicant's understanding and discussion of the references, if any, is consistent with the Examiner's understanding.

B. SPECIFICATION AMENDMENT

The Office Action requested status updates to the priority cases. Accordingly, Applicant has amended the specification as provided above to provide the current status of the identified priority cases.

C. PRIOR ART REJECTIONS

I. REJECTION UNDER 35 U.S.C. § 103

The Office Action rejected claims 1-2, 5-8, 10-12, and 15-20 under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 6,699,256 (*Logan*) and further in view of U.S. Patent No. 6,152,937 (*Peterson*). Claims 3-4 and 13-14 were rejected under 35 U.S.C. § 103(a) as being unpatentable over *Logan* in view of U.S. Patent No. 6,036,720 (*Abrams*), while also

¹ Although the prior art status of the cited art is not being challenged at this time, Applicant reserves the right to challenge the prior art status of the cited art at any appropriate time, should the need arise. Accordingly, any arguments and amendments made herein should not be construed as acquiescing to any prior art status of the cited art.

² Support for the claim amendments and/or new claims can be found throughout the specification and drawings as originally filed.

referencing *Peterson*, and claim 9 was rejected under 35 U.S.C. § 103(a) as being unpatentable over *Logan* in view of U.S. Patent No. 5,769,870 (*Salahieh*).

The Office Action asserts that "Logan et al. disclose[s] a method of manufacturing a clip-comprising the steps of providing material . . . removing portions . . . [and] heat treating the clip with a planar configuration" (Office Action, pages 2 and 3). In support of this assertion, the Office Action cited various portions of *Logan*. "As can be seen in FIG. 3 [of *Logan*], the pluralities of fingers have been formed from the cutting process, thus forming a plurality of open spaces 213 between fingers. Each of the pluralities of fingers is interconnected adjacent the medial portion 208" (Col. 7, ll. 42-46) "Once the nitinol tube has been cut to form the various fingers described hereinabove, *the fingers are deflected radially outwardly and may be heat treated to form the configuration shown in FIGS. 2 and 4*", i.e. a non-planar configuration (Col. 7, ll. 51-54).

As amended and presented herein, independent claims 1 and 10 recite, in part, "heat treating the clip with the clip in a planar configuration and the plurality of tines extending within the plane of the clip to program the plurality of looped elements of the clip and the plurality of tines to be biased to remain within the plane in the planar configuration," while independent claim 15 recites, in part, "heat treating the clip with the clip in a planar configuration and the pair of primary tines extending within the plane of the clip to program the plurality of looped elements of the clip and the pair of primary tines to be biased to remain within the plane in the planar configuration" (emphasis added).

Applicant respectfully submits that heat treating the clip so that "the plurality of looped elements of the clip and the plurality of tines [or the pair of primary tines] to be biased to remain within the plane in the planar configuration" is not the same as deflecting fingers "radially outwardly" from the nitinol tube to a non-planar configuration as taught by either *Logan* or *Peterson* (see *Peterson*, Col. 6, ll. 35-65). These appear to be opposite to each other.

Furthermore, the Office Action has not cited, nor has Applicant found any portion of *Abrams* or *Salahieh* that overcomes the deficiency of either *Logan* or *Peterson*. As such, Applicant respectfully submits that any combination of *Logan*, *Peterson*, *Abrams*, or *Salahieh* does not teach or suggest the inventions claimed in independent claims 1, 10, and 15, and for at least the same reasons neither teaches nor suggests the limitations of dependent claims 2-9, 11-

14, and 16-20. Consequently, Applicant requests the withdrawal of the rejection of claims 1-20 under Section 103.

D. CONCLUSION

In view of the foregoing, Applicant respectfully submits that the other rejections to the claims are now moot and do not, therefore, need to be addressed individually at this time. It will be appreciated, however, that this should not be construed as Applicant acquiescing to any of the purported teachings or assertions made in the last action regarding the cited art or the pending application, including any official notice. Instead, Applicant reserves the right to challenge any of the purported teachings or assertions made in the last action at any appropriate time in the future, should the need arise. Furthermore, to the extent that the Examiner has relied on any Official Notice, explicitly or implicitly, Applicant specifically requests that the Examiner provide references supporting the teachings officially noticed, as well as provide the required motivation or suggestion to combine references with the other art of record.

For at least the foregoing reasons, Applicant respectfully submits that the pending claims are neither anticipated by nor made obvious by the art of record. In the event that the Examiner finds any remaining impediment to a prompt allowance of this application that may be clarified through a telephone interview, the Examiner is requested to contact the undersigned attorney.

Dated this 16th day of March, 2009.

Respectfully submitted,

/Paul N. Taylor, Reg.# 57271/

PAUL N. TAYLOR
Registration No. 57,271
Attorney for Applicant
Customer No. 57360
Telephone No. 801.533.9800

FDR: kdj
2186850_1.DOC